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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/507,267

04/06/2005

Eugeny A. Lukhtanov

17682-005010US

4902

20350 7590 10/23/2008  
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EXAMINER

STAPLES, MARK

ART UNIT

PAPER NUMBER

1637

MAIL DATE

DELIVERY MODE

10/23/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/507,267	<b>Applicant(s)</b> LUKHTANOV ET AL.	
	<b>Examiner</b> Mark Staples	<b>Art Unit</b> 1637	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 25 September 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 09/25/2008. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 1, 2, 4-6, 10-20, 24, 25, 27-28, 30-32, and 57.
- Claim(s) withdrawn from consideration: 3, 7-9, 21-23, 26, 29, 38-56 and 58-63.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

/M. S./  
Examiner, Art Unit 1637

/Kenneth R Horlick/  
Primary Examiner, Art Unit 1637

Continuation of 11. does NOT place the application in condition for allowance because:

The arguments/remarks filed on 09/25/2008 have been entered. Response to these arguments follows.

The pending claims at issue remain rejected as given below.

#### Prior Art

Applicant argues that Sinyakov et al. do not teach a negatively charged minor groove binder moiety. Applicant argues that the carboxyl group which is a negatively charged moiety of Minor Groove Binder-4 (MGB-4) compound as taught by Sinyakov et al., is subsequently conjugated and through conjugation loses its charge. While Sinyakov et al. teach this conjugation they also teach Minor Groove Binder-4 by itself, that is, unconjugated. MGB-4 is specifically designated as a Minor Groove Binder and its structure as given in (1) of Figure 2 specifically shows a carboxyl group. Applicant has not presented any argument which negates this teaching by Sinyakov et al. Thus the rejection is maintained.

#### Double Patenting

Applicant argues that the patent claims do not teach or suggest a negatively charged minor groove binder. The rejection was made over the patent disclosure which teaches negatively charged minor groove binders and the patent claims which encompass the disclosed negatively charged groups in minor groove binders. It is further noted that claim 1 of the patent allows for substituted groups on Ar1 and AR2 and thus allows substituted negatively charged moieties as disclosed in the patent. Thus the instant claims, if allowed, would improperly extend the "right to exclude" already granted in the patent (see section 5 of Office Action mailed on 08/16/2007). Therefore the rejection is maintained.

#### Inventorship

The issue of inventorship is still pending. Applicant has not clarified and/or corrected the inventorship of the instant application (see section 6 of the Office action mailed on 06/25/2008).